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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,102	12/09/2005	Yuki Yamada	506.45680X00	8015

20457 7590 08/29/2008

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EXAMINER	
RUSSEL, JEFFREY E	

ART UNIT	PAPER NUMBER
1654	

MAIL DATE	DELIVERY MODE
08/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,102	YAMADA ET AL.	
	Examiner	Art Unit	
	Jeffrey E. Russel	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20060309;20051209*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The Sequence Listing filed February 13, 2007 is approved.

2. The disclosure is objected to because of the following informalities: The text at page 27, last two lines, of the specification should be deleted as being at best redundant to the sequence listing which has been filed in the application. Appropriate correction is required.

3. Claims 1-19 are objected to because of the following informalities: In claims 1, 3, 7, 9, 13, and 15, "N-terminal" should be changed to "N-terminus". In claims 2, 8, and 14, the phrase "amino acids of 3, 6, or 9 residues" should be changed to "3, 6, or 9 amino acid residues". In claims 4, 10, and 16, "is glycine" should be changed to "are glycine". Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese Patent Application 2003-137807. The Japanese Patent Application '807 teaches the tripeptides Gly-Pro-Ala, Gly-Pro-Hyp, Gly-Pro-Arg, and Gly-Pro-Ser, and teaches their use as a food or drink additive. The tripeptides are formed by collagenase digestion of collagen or gelatin. See, e.g., the attached Abstract, and, referring to the translation, page 1, claims 2, 3, and 6; page 13, paragraph [0023]; page 15, paragraph [0032]; page 18, paragraphs [0044] - [0046]; pages 19-20, paragraph [0053]; and page 30, paragraph [0108]. With respect to the preamble limitations "body taste enhancer" and "seasoning" in claims 1-12, 18, and 19, an intended use limitation does not impart patentability to product claims where the product is otherwise anticipated by the

prior art. With respect to instant claims 13-17, because the same product formed by the same process is added to the same food or drink according to the same method steps, inherently the addition of the tripeptides in the method of the Japanese Patent Application '807 will enhance the body taste of the food or drink to the same extent claimed by Applicants. Sufficient evidence of similarity is deemed to be present between the method of the Japanese Patent Application '807 and Applicants' claimed method to shift the burden to Applicants to provide evidence that Applicants' claimed method is unobviously different than the method of the Japanese Patent Application '807.

6. Claims 1, 2, 6-8, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by the Otagiri et al article (Bull. Chem. Soc. Jpn., Vol. 56, pages 1116-1119). The Otagiri et al article teaches the hexapeptide Gly-Pro-Pro-Phe-Ile-Val. The peptide exhibits a slightly bitter taste, with a threshold value determined as a mM concentration. CD of the peptide in water was also obtained. See, e.g., Table 1, Compound (9); page 1117, column 1, first and third paragraphs; and Figure 5. With respect to the preamble limitations "body taste enhancer" and "seasoning" in claims 1, 2, 6-8, and 12, an intended use limitation does not impart patentability to product claims where the product is otherwise anticipated by the prior art. With respect to instant claims 6 and 12-14, the solution in which the threshold value concentration was determined, and the water in which the CD was determined, correspond to the food or drink recited in Applicants' claims. With respect to instant claims 13 and 14, because the same product is added to the same food or drink according to the same method steps, inherently the addition of the hexapeptide in the method of the Otagiri et al article will enhance the body taste of the food or drink to the same extent claimed by Applicants. Sufficient evidence of similarity

is deemed to be present between the method of the Otagiri et al article and Applicants' claimed method to shift the burden to Applicants to provide evidence that Applicants' claimed method is unobviously different than the method of the Otagiri et al article.

7. Claims 1-4, 6-10, 12-16, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by the Kim et al article (J. Biochem. Mol. Biol., Vol. 34, pages 219-224). The Kim et al article teaches the isolated and purified nonapeptide Gly-Pro-Hyp-Gly-Pro-Hyp-Gly-Pro-Hyp, formed by collagenase digestion of bovine skin. The hydrolysate comprising the nonapeptide, and the purified nonapeptide, are dissolved in water. See, e.g., the Abstract. With respect to the preamble limitations "body taste enhancer" and "seasoning" in claims 1-4, 6-10, 12, 18, and 19, an intended use limitation does not impart patentability to product claims where the product is otherwise anticipated by the prior art. With respect to instant claims 6, 12-16, 18, and 19, the water in which the hydrolysate and in which the isolated nonapeptide are dissolved, correspond to the food or drink recited in Applicants' claims. With respect to instant claims 13-16, because the same product formed by the same process is added to the same food or drink according to the same method steps, inherently the addition of the nonapeptide in the method of the Kim et al article will enhance the body taste of the food or drink to the same extent claimed by Applicants. Sufficient evidence of similarity is deemed to be present between the method of the Kim et al article and Applicants' claimed method to shift the burden to Applicants to provide evidence that Applicants' claimed method is unobviously different than the method of the Kim et al article.

8. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese Patent Application 7-82299. The Japanese Patent Application '299 teaches a peptide

composition formed by collagenase digestion of collagen or gelatin and comprising a peptide $(Gly\text{-}X\text{-}Y)_{1\text{-}3}$. The peptide composition is used as a source of protein for foods. See, e.g., the Abstract. In view of the similarity in method of making and partial amino acid sequence, inherently the peptide of the Japanese Patent Application '299 will have the same amino acid sequence claimed by Applicants. With respect to the preamble limitations "body taste enhancer" and "seasoning" in claims 1-12, 18, and 19, an intended use limitation does not impart patentability to product claims where the product is otherwise anticipated by the prior art. With respect to instant claims 13-17, because the same product formed by the same process is added to the same food or drink according to the same method steps, inherently the addition of the peptides in the method of the Japanese Patent Application '299 will enhance the body taste of the food or drink to the same extent claimed by Applicants. Sufficient evidence of similarity is deemed to be present between the peptides and method of the Japanese Patent Application '299 and Applicants' claimed body taste enhancer/seasoning and method to shift the burden to Applicants to provide evidence that Applicants' claimed body taste enhancer/seasoning and method are unobviously different than the peptides and method of the Japanese Patent Application '299.

9. Claims 1, 4, 6, 7, 10, 12, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese Patent Application 2003-104997. The Japanese Patent Application '997 teaches the tetrapeptide Gly-Pro-Orn-Gly as a food seasoning. See, e.g., the attached abstracts and the translation. In view of the similarity of peptide sequence and use as a food seasoning, inherently the tetrapeptide of the Japanese Patent Application '997 will enhance body taste of a food or drink to the same extent claimed by Applicants. Sufficient evidence of

similarity is deemed to be present between the tetrapeptide and method of the Japanese Patent Application '997 and Applicants' claimed body taste enhancer/seasoning and method to shift the burden to Applicants to provide evidence that Applicants' claimed body taste enhancer/seasoning and method are unobviously different than the tetrapeptide and method of the Japanese Patent Application '997.

10. With respect to the Information Disclosure Statement filed August 11, 2006, a listing of the cited reference was not scanned into the Image File Wrapper. Accordingly, the cited reference has been listed in the attached Notice Of References Cited/PTO-892.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:00 A.M. to 5:30 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Cecilia Tsang can be reached at (571) 272-0562. The fax number for formal communications to be entered into the record is (571) 273-8300; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey E. Russel/
Primary Examiner, Art Unit 1654

JRussel
August 29, 2008